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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,721	03/28/2006	Georg Gros	DNAG-305	2415

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EXAMINER	
LIGHTFOOT, ELENA TSOY	
ART UNIT	PAPER NUMBER
1715	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

nyipdocket@fulbright.com

Office Action Summary	Application No.	Applicant(s)	
	10/540,721	GROS ET AL.	
	Examiner	Art Unit	
	ELENA Tsoy LIGHTFOOT	1715	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 June 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *41-96,107-111 and 114-117* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *41-96,107-111 and 114-117* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Response to Amendment

Amendment filed on June 25, 2010 has been entered. Claims 41-96, 107-111 and 114-117 are pending in the application.

Claims examined on the merits are 41-96, 107-111 and 114-117.

Specification

The amendment to the specification filed on June 25, 2010 has been entered.

Claim Objections

1. Objection to claim 79 because of the informalities has been withdrawn due to amendment.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Rejection of claims 43, 44, 65, 66, 85, 86, 114, and 115 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been withdrawn due to amendment.

4. Claims 47-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 47-49 recite limitation "at least partially anionically, cationically **or/and** radically curable" which contradicts limitation of claims 41-42 "at least partially anionically, cationically **or** radically curable". For examining purposes the limitation was interpreted as "at least partially anionically, cationically **or~~/and~~** radically curable".

Double Patenting

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Objection to claims 116-117 under 37 CFR 1.75 as being a substantial duplicate of claims 110-111 has been withdrawn due to amendment.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 41-96, and 107-109 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gros (DE 19925631A) in view of Koegler et al (US 5916979) for the reasons of record set forth in the previous Office Action mailed on 3/25/2010 because the amendment does not change the scope of claimed invention.

Applicant's arguments

(A) Applicants submit that the independent claims have been rewritten to recite that the composition "consists of" its recited components, which is believed to sufficiently distinguish from the cited references (Applicants did this solely to expedite prosecution in response to the Examiner's comments regarding the "open ended nature of certain claims at page 28 of the office action). Thus, all rejections should be withdrawn.

The Examiner respectfully disagrees with this argument. The amendment of the independent claims "composition consists of ~~comprises~~ a dispersion or solution containing at least two components…" does not change the scope of claimed invention because the amended independent claims read on the composition **containing** its recited components, and thus, the independent claims are still open-ended.

(B) Applicants argue that Koegler only relates to thick-layer coating of metallic substrates (col. 1, lines 10-11). At page 28 of the office action, the Examiner says she disagrees with this argument and alleges that one of ordinary skill in the art would have a reasonable expectation of success in applying thinner coating to metallic substrates at the same speed. However, the Examiner has not provided any reasoning or objective evidence as to why one would modify Koegler in this way, or even look to Koegler in view of his teaching away from the use of thinner coatings.

The Examiner respectfully disagrees with this argument. First of all, in contrast to Applicants assertion, Gros is modified by Koegler et al not Koegler et al is modified by Gros. Second, one of ordinary skill in the art would have motivation to combine Gros with teaching of Koegler et al, because Koegler et al teaches that coating materials, which can be processed in liquid form at room temperature, may be applied to strips (steel, zinc-plated steel, aluminum, etc.) on ***typical*** high-performance units in the coil-coating industry at high belt speeds (up to 200 m/min) and ensures highly uniform application of the coating (See column 1, lines 20-28). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a ***typical*** high-performance unit in the coil-coating industry for coating a metal strip in Gros with the expectation of providing the desired high belt speeds of up to 200 m/min and highly uniform application of the coating, as taught by Koegler et al.

9. Claims 41-57, 63-66, 71-78, 81-84, 87-90, 93, 94, 108-111 and 114-117 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emmons (US 4180598) in view of Koegler et

al '979 for the reasons of record set forth in the previous Office Action mailed on 3/25/2010 because the amendment does not change the scope of claimed invention.

10. Claims 41-66, 69-92, 95-96, and 107-109 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevenson et al (US 6087417) in view of Koegler et al '979 for the reasons of record set forth in the previous Office Action mailed on 3/25/2010 because the amendment does not change the scope of claimed invention.

11. Claims 58-59 and 85-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gros '631 in view of Koegler et al '979 or over Emmons '598 in view of Koegler et al '979, as applied above, and further in view of Kogure et al (US 5196487) for the reasons of record set forth in the previous Office Action mailed on 3/25/2010.

12. Claims 58-59 and 85-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gros '631 in view of Koegler et al '979 or over Emmons '598 in view of Koegler et al '979, as applied above, and further in view of Stevenson et al '417 for the reasons of record set forth in the previous Office Action mailed on 3/25/2010.

13. Claims 67-68, 87-88, and 93-94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevenson et al '417 in view of Koegler et al '979 or over Emmons '598 in view of Koegler et al '979, as applied above, further in view of Shustack (US 5,128,387) for the reasons of record set forth in the previous Office Action mailed on 3/25/2010.

14. Claims 110-111 and 116-117 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gros '631 in view of Koegler et al '979 or over Stevenson et al '417 in view of Koegler et al '979, as applied above, and further in view of Shustack '387 for the reasons of record set forth in the previous Office Action mailed on 3/25/2010.

15. Claims 110-111 and 116-117 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gros '631 in view of Koegler et al '979 or over Stevenson et al '417 in view of Koegler et al '979, as applied above, and further in view of Emmons '598 for the reasons of record set forth in the previous Office Action mailed on 3/25/2010.

16. Claims 114-115 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gros '631 in view of Koegler et al '979, as applied above, and further in view of Anderson et al (US 6,413,590) (See column 2, lines 24-30) and Field et al (US 3,658,943) for the reasons of record set forth in the previous Office Action mailed on 3/25/2010.

Conclusion

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELENA Tsoy LIGHTFOOT whose telephone number is (571)272-1429. The examiner can normally be reached on Monday-Friday, 9:00AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy Lightfoot, Ph.D.
Primary Examiner
Art Unit 1715

July 30, 2010

/Elena Tsoy Lightfoot/